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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,568	01/25/2007	Joachim Bruchlos	DE920030038US1	7936

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EXAMINER

RAVETTI, DANTE

ART UNIT	PAPER NUMBER
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3685

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03/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,568	Applicant(s) BRUCHLOS ET AL.	
	Examiner DANTE RAVETTI	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 and 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-29 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This communication is in response to the original Application No. 10/596,568 filed on December 1, 2004.
2. Claims 1-20 and 30-34 have been cancelled by the Applicant.
3. Claims 21-29 and 35-40 are currently pending and have been fully examined.
4. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

Election/Restrictions

5. Applicant's election, with traverse, of claims 21-29 and 35-40 in the reply filed on March 5, 2009 is acknowledged.

Priority

6. Priority for this application is set to 12/22/2003, the filing date of the foreign priority application #: 03104906.7 in the European Patent Office (EPO).
7. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. §112.¹

¹ See Transco Products, Inc. v. Performance Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Examiner's Comments/Remarks

8. As to claim 25, Applicant recites, "...wherein the meter event request is stored in the cache memory **if** the actual number...." Language that suggests or makes optional, but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.² The appropriate correction is required.

Specification

9. Objection to the Specification is being made. The title of the invention is not sufficiently descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "Receiving licensed content based on parameters stored in cache memory"

Claim Rejections - 35 USC § 101

10. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 21-29 and 35-40 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular

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apparatus) or (2) transform the underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity.¹

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 21 fails prong (3) because the tie to a particular apparatus, is a mere extra-solution activity. Therefore, claim 21 does not meet the requirements of the third prong (3).

Claims 22-29 are also rejected for being dependent upon rejected claim 21. The appropriate correction is required.

Claim 35 is directed to a "program product." A "program product" is software, and according to the MPEP, software, without a computer readable medium storing the software **when executed, causes the computer to perform specific method steps,**

² MPEP §2106 II C;

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is non-functional descriptive material and is therefore rejected under 35 U.S.C §101.³ A “computer program”, as claimed, is not one of the four statutory classes of invention, as it is merely data. The appropriate correction is required.

Claims 36-40 are also rejected for being dependent upon rejected claim 35. The appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 21-29 and 35-40 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 21, Applicant recites, “comparing the actual content of a cache memory....” However, Applicant is silent the step of first “reading” the cache memory. Applicant is also silent to what data or information is to be read. For example, is the Applicant reading the “**entire**” contents of the cache memory, or just reading specific identifiers or locations? One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As to claim 21, Applicant recites, “sending...the content of the cache memory...” it is unclear what specific content is being sent. Is the Applicant sending the **entire** content of cache to metering service, or just select content or identifiers? One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

³ MPEP §2106.01;

As to claim 23, Applicant recites, "...comparing said value...with the content of the cache memory." It is unclear if the Applicant is comparing data with the **entire** contents of cache memory? One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As to claim 24, Applicant recites, "...deleting the content of the cache memory..." It is unclear if the Applicant means to delete the **entire** contents of the cache, or to delete specific identifiers or specific content? One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 26 recites the limitation "the kinds and amount of services" in claim 26. There is insufficient antecedent basis for this limitation in the claim.

Claims 35-38 and 40 are also rejected for containing similar language or like deficiencies.

Claims 25-29 and 39-40 are also rejected for being dependent upon rejected claims 20-24 and 35-38. The appropriate correction is required.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 21-29 and 35-40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Perinpanathan, (US 2002/0083145) ("Perinpanathan") and in view of Mori, (US 2003/0005458) ("Mori").

As to claims 21 and 35:

Perinpanathan teaches substantially as claimed:

receiving a service request message from a service consumer (See at least [0029], [0037], [0042]-[0043], [0047]);

generating a meter event request associated with the service request (See at least Abstract, [0007], [0010], [0011], [0012], [0028], [0030], [0033]);

Perinpanathan does not expressly teach:

comparing the actual content of a cache memory with at least one parameter;

storing the meter event request in the cache memory or sending the meter event request and the content of the cache memory to a metering service in order to process the meter event:

requests based on the comparison;

wherein said at least one parameter is associated with the service request and a predefined convention, and said parameter defines how many meter event requests may be stored in the cache memory.

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However, Mori expressly teaches:

comparing the actual content of a cache memory with at least one parameter (See at least [0033], [0054], [0119]-[0120], [0127]-[0128], Figure 9, Claim 9, 18, 44, 47);

storing the meter event request in the cache memory or sending the meter event request and the content of the cache memory to a metering service in order to process the meter event (See at least [0033], [0054], [0119]-[0120], [0127]-[0128], Figure 9, Claim 9, 18, 44, 47);

wherein said at least one parameter is associated with the service request and a predefined convention, and said parameter defines how many meter event requests may be stored in the cache memory (See at least [0033], [0054], [0119]-[0120], [0127]-[0128], Figure 9, Claim 9, 18, 44, 47);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Perinpanathan to include the features of Mori because in the field of providing access to content, tracking user usage of content ensures that only properly authorized content is rendered.

As to claims 22 and 36:

The combination of Perinpanathan/Mori discloses as discussed above; however, the combination of Perinpanathan/Mori does not expressly teach:

wherein comparing the actual content of a cache memory with at least one parameter comprises evaluating a status of a boolean parameter which indicates if the meter event request is allowed to be stored in the cache memory.

However, the use of a Boolean parameter to control stored information in cache memory is old and well known in the art.

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As to claims 23 and 37:

Perinpanathan does not expressly teach:

wherein comparing the actual content of a cache memory with at least one parameter comprises:

evaluating a value of an integer parameter associated with the boolean parameter; and

comparing said value of the integer parameter with the content of the cache memory.

However, Perinpanathan does expressly teach:

[0048] After acquiring a OOA 306, the user of UD 104, by way of operations 600 (FIG. 6) can interact with content locally or content retrieved from CS 108 (S602). If the content for which interaction is desired is remote (i.e., not local to UD 104), UD 104 may initiate a communication session with CS 108, via network 102, to retrieve the desired content (S602). Content retrieved from CS 108 or from a local source will be stored in content cache 314 for quick retrieval. The content retrieved (whether remote or local) may include policies that instruct TA 320 how, what and when to track interactions with such content.

Therefore, a predictable result of Perinpanathan would have been to perform some type of determination to determine if the content was locally stored.⁴

As to claims 24 andn 38:

Perinpanathan expressly teaches:

further comprising sending the meter event request to the metering service in order to process the meter event request (See at least [0026], [0028]-[0029], [0032]); and

⁴ Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement.

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The combination of Perinpanathan/Mori discloses as discussed above; however, the combination of Perinpanathan/Mori does not expressly teach:

deleting the content of the cache memory if the actual number of the meter event requests in the cache memory equals or increases the value of the integer parameter.

However, deleting the content of cache is old and well known in the art.

As to claims 25 and 39:

Perinpanathan expressly teaches:

wherein the meter event request is stored in the cache memory if the actual number of the meter event requests in the cache memory is less than said value of the integer parameter (See at least [0039]-[0041]);

As to claims 26 and 40:

Perinpanathan expressly teaches:

wherein the predefined convention is defined in a license contract which relates to the kinds and amount of services between a service provider and the service consumer (See at least Abstract);

As to claim 27:

Perinpanathan expressly teaches:

wherein a relevant information is separated from the service request message after receiving the service request message (See at least [0029], [0037], [0042]-[0043], [0047]).

As to claim 28:

Perinpanathan expressly teaches:

wherein the relevant information of the service request message comprises at least one of request data, contract data, license data, the boolean parameter, the integer parameter and the identity of the service consumer (See at least [0029], [0037], [0042]-[0043], [0047]).

As to claim 29:

Perinpanathan expressly teaches:

counting the services when the associated meter event request is sent to the metering service (See at least Abstract, [0007], [0010]-[0012], [0030], [0033], [0038]); and

sending the actual counting results to at least one of a service provider and the service consumer (See at least Abstract, [0007], [0010]-[0012], [0030], [0033], [0038]).

As to claims 30-34:

Have been cancelled by the Applicant.

16. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the applicant. Although the specified citations are representatives of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

-DeKoning et al., (US 5,761,705); Claim 7. The method of claim 1 wherein each of said cache memories has a validity boolean attribute indicating, if having a value of true, that the associated cache memory has remained non-volatile and wherein each of said cache memories has a native boolean attribute indicating, if having a value of true, that the contents stored in the cache memory was last associated with the RAID storage subsystem and wherein the determining step includes:

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Claim 13. The apparatus of claim 9 wherein each of said cache memories has a native boolean attribute indicating, if having a value of true, that the contents stored in the cache memory was last associated with the RAID storage subsystem and wherein the means for determining includes:

- Fujii et al., (US 6,119,150); The parallel processor system further includes an inter-processor network interconnecting the processors, a first circuit which, when the content of the main memory location to store the data that the processor has received through the inter-processor network differs between the cache memory and the main memory, copies back the content of the main memory from the cache memory to the main memory and erases from the cache memory the content of the main memory to store the received data, and a second circuit for writing the receive data into the main memory after the erase operation by the first circuit. (Col. 3, lines 27-45)

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, please contact the Electronic Business Center (EBC) at 1-(866)

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/Dante Ravetti/
Examiner, Art Unit 3685
Friday, March 20, 2009

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685